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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/895,950 07/17/97 WINTER

A HOE-90/F-333

EXAMINER

IM52/0306

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WILMINGTON DE 19899

TESKIN, F

ART UNIT

PAPER NUMBER

19

1713

DATE MAILED:

03/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/895,950

Applicant(s)

Winter, et al.

Examiner

Fred Teskin

Group Art Unit
1713



☒ Responsive to communication(s) filed on January 2 and January 24, 2001

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three (3) month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-15 and 19-26 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-15 and 19-26 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☒ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The finality of the Office action of August 24, 2000 is hereby withdrawn and prosecution reopened so that new grounds of rejection, as detailed below, may be entered.

2. The amendments filed January 2 and January 24, 2001 propose amendments to claims 1, 19, 25 and 26 that do not comply with 37 CFR 1.121(b), which sets forth the manner of making amendments in reissue applications. Specifically, the amendment to claim 1 removes the second occurrence of "a halogen atom" in the definition of R^4 by using brackets. The second occurrence of this term was, however, already deleted by certificate of correction for the original patent; therefore, such amendment is unnecessary. In addition, claims 19, 25 and 26 include bracketing but none of said claims was present in the original patent. As all amendments to the claims are made vis-a-vis the patent claims, claims 25 and 26 should only be underlined and all bracketed matter simply omitted, with an explanation for the deletions provided in the remarks.

Applicants are required to correctly amend the reissue application in the response to this Office action.

3. With respect to the assent of assignee filed December 4, 1997, it is noted that the assignee of the patent for which reissue is sought has changed; according to Office records, the new assignee

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is Targor GMBH. Accordingly, a new assent of assignee complying with the requirements of 37 CFR 1.172 and 3.73(b) is required.

4. Claims 19-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 19 [and claims dependent thereon] is indefinite due to lack of definition for variable "p" in formula (I). Note that the definition of "p" was deleted from claim 19 by the amendment of January 24, 2001, but the variable still appears in the underlined formula. Appropriate correction is required.

5. Claims 21-24 are rejected under 35 USC 251 for lack of error in obtaining the original patent.

Claims 21 and 22 are drawn to a catalyst composition; however, in the patent file, claim 8, also drawn to a catalyst composition, was subject to restriction (see the action of January 13, 1992) and later cancelled to place the application in condition for allowance. No divisional application was filed claiming the subject matter cancelled from the patent file. The failure to timely file a divisional application is not an error correctable by reissue of the original patent. See MPEP 1450.

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6. Claims 1-16 and 19-26 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In the original patent application, the limitation of "for preparing essentially isotactic olefin polymers" was inserted into claim 1 to distinguish the claims over the prior art. See the Amendment of September 25, 1992, page 4, where a prior art rejection was traversed in part by arguing that the aforementioned phrase "acts as a limitation and defines the scope of the invention". Note also the Declaration of May 18, 1993, wherein it

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is stated that the polymers prepared in accordance with the present invention exhibit a significantly higher isotacticity. Deletion of this limitation from the claims of this reissue application is therefore deemed to engender impermissible recapture of surrendered subject matter. See MPEP 1412.02 in this regard.

7. Applicant is reminded that any subsequent amendment to the specification and/or claims must comply with 37 C.F.R. § 1.121(b) and that correction of additional errors that are not merely spelling, grammar, typographical, editorial or clerical errors will require a supplemental oath or declaration complying with 37 CFR 1.175(b)(1). See *In re Constant*, 3 USPQ2d 1479.

8. In view of the new grounds of rejection *supra*, this action is made non-final.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner F. M. Teskin whose telephone number is (703) 308-2456.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (703) 308-2450. The appropriate fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.



FRED TESKIN
PATENT EXAMINER
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FMTeskin/03-01-01